

REMARKS

Claims 1-24 are pending in this application. Further examination of the present application is hereby requested in view of the following remarks. Applicants believe that the present application is now in condition for allowance and prompt and favorable action is respectfully solicited.

35 U.S.C. § 103 Rejections

1. Claims 1-4, 7-10, 13-16 and 19-22 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kallin et al., U.S. Patent No. 6,058,308 (“Kallin”) in view of Ho et al., U.S. Patent No. 5,943,621, (“Ho”), and further in view of Funato et al., U.S. Application Publication No. 2003/0143999 (“Funato”).

a. Independent claims 1, 7, 13 and 19

i. “subject matter as a whole”

A claim is obvious only when the subject matter of that claim as a whole would have been obvious to a person having ordinary skill in the art. 35 U.S.C. §103(a). Here, all of the claims require that the target mobile station (MS), after registering when a number of cells identified in a first list is equal to a predetermined limit, move the cells identified in the first list, other than a cell in which the MS last registered, to a second list. The Examiner relies upon Funato as teaching “moving the cells identified in a first list [CLT] other than cell in which the MS last registered, to a second list [PLT],” citing Funato, pages 5-6, paragraph [0088]. However, the cited portion of Funato does not support the Examiner’s fact finding.

The cited portion of Funato reads as follows:

[0088] FIG. 20 is an operational block diagram of the host reporter agent (HRA) 908 in a MH 902 (FIG. 9). The HRA includes a reporter process (REPF) 2002, and a previous location table (PLT) 2004 and a current location table (CLT) 2006. As the MH travels, the REPF 2002 updates the both PLT 2004 and CLT 2006 and registers the MH with a new

area. The reporter process 2002 reports paging area movement to the current paging area clustering agent. As is indicated in FIG. 20, the PLT 2004 stores the paging identifier (PID) and the network access identifier (NAI) for the previous paging area clustering agent. Similarly, the CLT 2006 stores the paging identifier (PID) and the network access identifier (NAI) for the current paging area clustering agent. When the MH moves to another paging area, the reporter process 2002 moves the current location table 2006 information to the previous location table 2004.

As is seen from this passage, upon registration in a new paging area, the MH (MS of the present claims) of Funato moves the current location table [CLT] (first list of the present claims) to the previous location table [PLT] (second list of the present claims). There is no disclosure in the relied upon passage of Funato that the cell in which the MH last registered is retained in the CLT as stated in the present claims. Rather, the last registered cell--the CLT of Funato--is moved to the PLT. Absent clarification of where Funato describes this aspect of the present claims, the Examiner's obviousness rejection is legally erroneous as it does not account for the subject matter of the claims as a whole. 35 U.S.C. § 103(a).

ii. "hindsight"

The Examiner's obviousness rejection is first premised upon a combination of Kallin and Ho. OA, pages 3-4. In this combination the Examiner asserts that it would have been obvious to modify Kallin to "limit the number of stored cell Ids as a mobile moves through a network" as purportedly taught by Ho. *Id.*, page 4. The Examiner then proposes to modify the "combination of Kallin and Ho to include moving the cells stored in the movement history stack

to a second list when the mobile terminal registers with a new cell during movement” as purportedly taught by Funato. *Id.* The identified “motivation” to make this modification of the “combination of Kallin and Ho” is stated to be to “conserve battery power dissipated by the mobile terminal and minimize paging costs by reducing location updates when the mobile terminal moves back to a previously visited cell.” *Id.*, pages 4-5.

Viewing Kallin, Ho and Funato together without knowledge of the present disclosure and claims, as one must in making an obviousness determination, it is readily seen that there is no reason to combine the references as proposed by the Examiner. The invention of Ho involves eliminating so-called “loops” when tracking the path of a mobile device. Assuming arguendo that it would have been obvious to modify Kallin to accommodate the teachings of Ho--a point not conceded--there is no discernable reason why one would look to Funato to further modify this combination. The Examiner has not identified any commonality in the systems of Kallin and Ho that would have lead a person of ordinary skill in the art to look towards Funato for any reason. Further the Examiner’s stated motivation to modify the combination of Kallin and Ho by Funato as proposed lacks factual support. Ho already satisfies the identified motivation of conserving battery power dissipated by the mobile terminal and minimizing paging costs by reducing location updates when the mobile terminal moves back to a previously visited cell by eliminating loops in the mobile device path. The only apparent reason for the Examiner’s additional reliance upon Funato is impermissible hindsight in view of the present application.

b. Dependent claims 3, 4, 8-10, 14-16 and 20-22

These claims depend either directly or indirectly from one of the independent claims, and include all the subject matter of, claims 1, 7, 13 and 19, and should be allowed for at least the same reasons presented above regarding the independent claims as well as the additionally recited features found in the claims. Because independent claims 1, 7, 13 and 19 are believed to be allowable, Applicant has not argued or otherwise relied on independent patentability of dependent claims, but reserves the right to do so in this or any subsequent proceeding.

2. Claims 5, 6, 11, 12, 17, 18 23 and 24 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kallin, Ho, Funato and Papadimitriou et al., U.S. Application Publication No. 2002/0187793 (“Papadimitriou”)

These claims depend either directly or indirectly from one of the independent claims, and include all the subject matter of, claims 1, 7, 13 and 19, and should be allowed for at least the same reasons presented above regarding the independent claims as well as the additionally recited features found in the claims. Because independent claims 1, 7, 13 and 19 are believed to be allowable, Applicant has not argued or otherwise relied on independent patentability of dependent claims, but reserves the right to do so in this or any subsequent proceeding.

CONCLUSION

In light of the remarks contained herein, Applicants submit that the application is in condition for allowance, which is hereby requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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